

REMARKS

Claims 1-10 are pending in the application. Reconsideration of this application is respectfully requested.

The Office Action indicates that final drawings formalizing the corrections approved by the Examiner should be submitted with this response. Formal drawings are attached hereto as replacement drawings, subject to the approval of the Examiner.

The Office Action rejects claims 1 and 2 under 35 U.S.C 103(a) as unpatentable over U.S. Patent No. 5,284,364 to Jain, hereafter Jain in view of U.S Patent No. 5,900,954 to Katz et al., hereafter Katz.

This rejection is erroneous. Independent claim 1 recites the combination of an information carrier having a surface for the readout of optically readable information and a transparent copy protection film with a property that rotates the polarization of the readout light and/or a filtering property is introduced onto the external surface of the carrier. Jain discloses a base print upon which an image and/or alphanumeric information is recorded in a clear area. Jain laminates a film of polyvinyl alcohol that has been stretched to render it polarizing to the base print in all areas except the clear area. This results in only the clear area being visible. Jain teaches to record information in the film by removing portions of the film to form an information pattern of clear areas. The information pattern is readable only when a polarizing layer P1 is overlaid upon the polarizing film. Thus, Jain's film acts as a copy protection film.

The Examiner admits that Jain does not disclose or teach an information carrier with at least one external surface for the readout of optically readable information that contains holographically recorded information. The Examiner alleges that Katz shows that the ability of having holographic images on the

surface of "these cards" is well known, citing Katz's abstract and column 1, lines 44 to column 2, line 2. The cited passage, which is from the Background of the Invention section of Katz, describes a credit card that includes a holographic display of an image that is visible to the naked eye in ordinary light. Katz does not disclose in the cited passage or elsewhere a copy protection film that is on the credit card surface. That is, KATZ does not provide a polarization-altering overlay as a copy-protecting film that prevents copying underlying information.

The Examiner provides no motivation for one of ordinary skill in the art to provide Jain's information carrier with a hologram as described in Katz. In fact, the suggested combination of Jain and Katz is improperly based on the hindsight of Applicants' disclosure. Such hindsight reconstruction of the art cannot be the basis of a rejection under 35 U.S.C. 103. The prior art itself must suggest that modification or provide the reason or motivation for making such modification. In re Laskowski, 871 F.2d 115, 117, 10 USPQ 2d 1397, 1398-1399 (CAFC, 1989). "The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." Sensonics Inc. v. Aerosonic Corp. 38 USPQ 2d 1551, 1554 (CAFC, 1996), citing Interconnect Planning Corp. v. Feil, 774 F. 2d 1132, 1138, 227 USPQ 543, 547 (CAFC, 1985).

In particular, one of ordinary skill in the art would have no motivation to combine a hologram from Katz's credit card that has no copy protected film with Jain's information carrier that has a copy protection film.

For the reasons set forth above, it is submitted that the rejection of claims 1 and 2 under 35 U.S.C. 103(a) is erroneous and should be withdrawn.

The Office Action rejects claims 3-5 and 9 under 35 U.S.C 103(a) as unpatentable over Jain and Katz as applied to claim 1 and further in view of U.S Patent No. 3,836,754 to Toye et al., hereafter Toye.

This rejection is erroneous for the reason set forth in the discussion of claim 1, upon which claims 3-5 and 9 are dependent.

For the reasons set forth above, it is submitted that the rejection of claims 3-5 and 9 under 35 U.S.C. 103(a) is erroneous and should be withdrawn.

The Office Action rejects claim 6 under 35 U.S.C 103(a) as unpatentable over Jain and Katz as applied to claims 1 and 2 and further in view of U.S Patent No. 4,982,073 to Stenzel, hereafter Stenzel.

This rejection is erroneous for the reason set forth in the discussion of claim 1, upon which claim 6 is dependent.

For the reasons set forth above, it is submitted that the rejection of claim 6 under 35 U.S.C. 103(a) is erroneous and should be withdrawn.

The Office Action rejects claim 7 under 35 U.S.C 103(a) as unpatentable over Jain, Katz and Stenzel as applied to claim 6 and further in view of U.S Patent No. 4,820,912 to Samyn, hereafter Samyn.

This rejection is erroneous for the reason set forth in the discussion of claim 1, upon which claim 7 is dependent.

For the reasons set forth above, it is submitted that the rejection of claim 7 under 35 U.S.C. 103(a) is erroneous and should be withdrawn.

The Office Action rejects claim 8 under 35 U.S.C 103(a) as unpatentable over Jain, Katz and Stenzel as applied to claim 6 and further in view of U.S Patent No. 5,111,033 to Fujita et al., hereafter Fujita.

This rejection is erroneous for the reason set forth in the discussion of claim 1, upon which claim 8 is dependent.

For the reasons set forth above, it is submitted that the rejection of claim 8 under 35 U.S.C. 103(a) is erroneous and should be withdrawn.

The Office Action rejects claim 10 under 35 U.S.C 103(a) as unpatentable over Jain and Katz as applied to claim 1 and further in view of U.S Patent No. 6,164,548 to Curiel, hereafter Curiel.

This rejection is erroneous for the reason set forth in the discussion of claim 1, upon which claim 10 is dependent.

For the reasons set forth above, it is submitted that the rejection of claim 10 under 35 U.S.C. 103(a) is erroneous and should be withdrawn.

The Office Action cites a number of patents that were not applied in the rejections of the claims. These patents have been reviewed, but are believed to be inapplicable to the claims.


It is respectfully requested for the reasons set forth above that the objection to the specification be withdrawn, that the rejections under 35 U.S.C. 103(a) be withdrawn, that claims 1-10 be allowed and that this application be passed to issue.

For the reasons set forth above, it is submitted that this amendment places the application in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and passed to issue.

If this amendment is deemed to not place the application in condition for allowance, it is respectfully requested that it be entered for the purpose of appeal.

Respectfully Submitted,

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